

## **REMARKS / ARGUMENTS**

### **I. General Remarks**

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application and the references cited by Applicants in this application.

As set forth above, Applicants have requested continued examination in this application, in accordance with 37 C.F.R. § 1.114. Moreover, Applicants respectfully request that the amendments presented herein be entered and further request consideration of the claims in light of the amendments and remarks contained herein.

### **II. Disposition of Claims**

At the time of the Advisory Action, claims 1-3, 8-11, 13-31, 35-41, and 43-65 were pending in this application. Claims 1-3, 8-11, 13-31, 35-41, 43-65 stand rejected. Claims 1, 2, 31, 35, 37, and 57 have been amended herein. These amendments and additions are supported by the specification as filed. It should not be assumed that these amendments were made for reasons relating to patentability.

### **III. Remarks Regarding Rejections Under 35 U.S.C. § 103**

#### **A. Claims 1-3, 8-11, 13-25, 31, 35-41, 43-54, and 57-65**

Claims 1-3, 8-11, 13-25, 31, 35-41, 43-54, and 57-65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 6,006,838 to Whiteley *et al.* (hereinafter “*Whiteley*”) in view of WO 03/048508 by Akinlade *et al.* (hereinafter “*Akinlade*”). In response to Applicants’ arguments filed on May 16, 2008, the Advisory Action states:

Applicant’s arguments are not persuasive. Applicant has argued that Examiner has completely changed the function of the Whiteley device by saying that the Whiteley device could be used to fracture a formation. Examiner respectfully disagrees. Examiner is simply saying the even when using Whiteley’s device under normal operation, it is completely capable of fracturing a formation. Inadvertent fracturing, though undesirable, does in fact occur. The scope of the independent claims is sufficiently broad that a situation in which Whiteley’s device unintentionally fracture a formation (regardless of the size of the fractures) would infringe on the claims. Examiner is not modifying[.] Furthermore, applicant has provided no evidence as to why Whiteley’s device is completely incapable of fracturing a formation. Lastly, with regard to applicant’s allegation that Whiteley and Akinlade cannot

be combined, examiner simply reiterates that Whiteley discloses a stimulation device attached to “drillpipe,” and Akinlade simply provides further evidence that a fluid injection device could be used in a drilling operation. The type of fluid being injected does not constitute teaching away from the combination, because the linking element between Whiteley and Akinlade is simply that some fluid is being injected into a formation, regardless of what kind of fluid it is.

(Advisory Action at 2.) Applicants respectfully disagree.

In order for a reference or combination of references to form the basis for a rejection under § 103(a), a *prima facie* case of obviousness must be established. Obviousness is determined by construing the scope of the prior art, identifying the differences between the claims and the prior art, determining the level of skill in the pertinent art at the time of the invention, and considering objective evidence present in the application indicating obviousness or nonobviousness. *Graham v. John Deere*, 383 U.S. 1, 17 (1966). Applicants respectfully submit that due to the differences between the claims and the cited references the Examiner has not established a *prima facie* case of obviousness, in that the combination of *Whiteley* and *Akinlade* does not teach each and every recitation of the present claims. In addition, Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness because *Akinlade* teaches away from the proposed combination with *Whiteley*.

**1. The Cited References Do Not Teach the Selecting a Section of the Subterranean Formation to Fracture Limitation of Claims 1, 31, and 57.**

Applicants have previously argued that neither *Whiteley* nor *Akinlade* teach or suggest “fracturing a section of the subterranean formation,” as recited in claims 1 and 57 or “fracturing multiple sections of the subterranean formation,” as recited in claim 31. The Examiner has argued that the cited references teach this limitation because “inadvertent fracturing” does in fact occur and the “scope of the independent claims is sufficiently broad” to include inadvertent fracturing. However, even if the alleged “inadvertent fracturing” of *Whiteley* could occur, Applicants respectfully submit that neither *Whiteley* nor *Akinlade* teach or suggest “selecting the section of the subterranean formation to fracture,” as recited in claims 1 and 57 or “selecting multiple sections of the subterranean formation to fracture,” as recited in claim 31. Rather, the Examiner has only argued that these references may teach accidental fracturing and thus would not teach the step of selecting a section of the subterranean formation to fracture.

Furthermore, since the Examiner states he is not modifying the *Whiteley* reference in his rejection, this limitation is clearly not taught. Accordingly, the combination of *Whiteley* and *Akinlade* fails to teach or suggest each and every limitation of independent claims 1, 31, and 57. Therefore, Applicants respectfully assert that independent claims 1, 31, and 57, and their dependent claims, are not rendered obvious by the combination of *Whiteley* and *Akinlade*.

**2. *Akinlade* Teaches Away from a Combination with *Whiteley*.**

In addition, Applicants respectfully submit that the combination of *Akinlade*, which is directed to sealing a subterranean formation, with *Whiteley*, which is directed to matrix acidizing, would fail to obviate these claims, because such a combination would be improper. In determining whether a combination is proper, “[a] prior art reference must be considered in its entirety, *i.e.* as a whole, including portions that would lead away from the claimed invention.” MPEP § 2141.02.VI. As the Examiner states, “*Akinlade*’s system is not used for *stimulating* a wellbore, rather it is for *sealing* a wellbore.” (Final Office Action at 3-4.) Although the Examiner argues that the fact that the injected fluid is a sealing fluid is immaterial because the *Akinlade* reference is merely being used for its teaching of injecting a fluid during a drilling operation, Applicants disagree. In using the teaching of *Akinlade* of injecting a fluid during a drilling operation without giving consideration to what type of fluid is being injected, *the Examiner is not considering the prior art reference as a whole*. *Akinlade* teaches away from stimulating a wellbore during a drilling operation. In particular, *Akinlade* teaches that shutting off fractures during drilling operations is highly desirable and that fractures may lead to a multitude of problems during drilling operations. See *Akinlade*, page 1. *Akinlade* also teaches that similar problems are encountered when drilling through highly permeable zones. See *Akinlade*, page 1. A person of ordinary skill in the art, when considering *Akinlade* as a whole, would understand that *Akinlade* teaches away from stimulating a subterranean formation during a drilling operation. Thus, it is improper for the examiner to rely on the teaching of *Akinlade* of injecting a fluid during a drilling operation without considering the fact that *Akinlade* only teaches injecting a sealing fluid. As such, it would be improper to combine *Akinlade* with *Whiteley*, which is directed to the matrix acidizing of a producing zone, because *Akinlade* teaches away from stimulating a subterranean formation during a drilling operation.

**3. The Rejection Over *Whiteley* and *Akinlade* Should Be Withdrawn.**

For at least the foregoing reasons, Applicants respectfully assert that independent claims 1, 31, and 57, and their dependent claims, are not rendered obvious by the combination of *Whiteley* and *Akinlade*. Thus, Applicants respectfully request withdrawal of this rejection with respect to claims 1-3, 8-11, 13-25, 31, 35-41, 43-54, and 57-65.

**B. Claims 26, 27, 30, 55, and 56**

Claims 26, 27, 30, 55, and 56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Whiteley* in view of *Akinlade* and in further view of U.S. Patent No. 5,111,881 issued to Soliman *et al.* (hereinafter “*Soliman*”). As discussed in Section II (A) above, *Whiteley* in view of *Akinlade* does not teach or suggest “selecting the section of the subterranean formation to fracture” or “selecting multiple sections of the subterranean formation to fracture,” as recited in independent claims 1 and 31. Nor does the combination of *Whiteley* and *Akinlade* with *Soliman* teach this element. Rather, the Examiner merely relies on *Soliman* for its alleged teaching of sealing a treated subterranean formation. (Final Office Action at 5.) Applicants therefore respectfully assert the combination of *Whiteley*, *Akinlade*, and *Soliman* does not teach, suggest, or otherwise disclose all elements of claims 1 and 31 and thus these claims are allowable over *Whiteley*, *Akinlade*, and *Soliman*. Since claims 26, 27, 30, 55, and 56 depend, either directly or indirectly, from claim 1 or 31, these dependent claims also incorporate these limitations that none of the references teach or suggest, and are thus similarly allowable. See 35 U.S.C. § 112 ¶ 4 (2004).

**C. Claims 26-29, 55, and 56**

Claims 26-29, 55, and 56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Whiteley* in view of *Akinlade* in further view of U.S. Reissued Patent No. 27,459 issued to Guinn *et al.* (hereinafter “*Guinn*”). As discussed in Section II (A) above, *Whiteley* in view of *Akinlade* does not teach or suggest “selecting the section of the subterranean formation to fracture” or “selecting multiple sections of the subterranean formation to fracture,” as recited in independent claims 1 and 31. Nor does the combination of *Whiteley* and *Akinlade* with *Guinn* teach this element. Rather, the Examiner merely relies on *Guinn* for its alleged teaching of sealing a treated subterranean formation. (Final Office Action at 6.) Applicants therefore respectfully assert the combination of *Whiteley*, *Akinlade*, and *Guinn* does not teach, suggest, or otherwise disclose all elements of claims 1 and 31 and thus these claims are

allowable over *Whiteley*, *Akinlade*, and *Guinn*. Since claims 26-29, 55, and 56 depend, either directly or indirectly, from claim 1 or 31, these dependent claims also incorporate these limitations that none of the references teach or suggest, and are thus similarly allowable. *See* 35 U.S.C. § 112 ¶ 4 (2004).

**D. Claims 66 and 67**

Claims 66 and 67 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Whiteley* in view of *Akinlade* in further view of U.S. Patent Publication No. 2003/0083403 by Dawson *et al.* (hereinafter “*Dawson*”). As discussed in Section II (A) above, *Whiteley* in view of *Akinlade* does not teach or suggest “selecting the section of the subterranean formation to fracture” or “selecting multiple sections of the subterranean formation to fracture,” as recited in independent claims 1 and 31. Nor does the combination of *Whiteley* and *Akinlade* with *Dawson* teach this element. Rather, the Examiner merely relies on *Dawson* for its alleged teaching of injecting an additive fluid simultaneously with a fracturing fluid. (Final Office Action at 6.) Applicants therefore respectfully assert the combination of *Whiteley*, *Akinlade*, and *Dawson* does not teach, suggest, or otherwise disclose all elements of claims 1 and 31 and thus these claims are allowable over *Whiteley*, *Akinlade*, and *Dawson*. Since claims 66 and 67 depend, either directly or indirectly, from claim 1 or 31, these dependent claims also incorporate these limitations that none of the references teach or suggest, and are thus similarly allowable. *See* 35 U.S.C. § 112 ¶ 4 (2004).

**IV. No Waiver**

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art.

## SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants have hereby authorized the Commissioner to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0478, in the amount of \$810.00 for the RCE fee under 37 C.F.R. § 1.17(e). Should the Commissioner deem that any additional fees are due, the Commissioner is authorized to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0478, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,



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